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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/548,719
Filing Date: April 13, 2000
Appellant(s): BARSTOW ET AL.

Bradley J. Meier
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/16/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The Appellant's statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

The Appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of the Invention*

The summary of the invention in the brief is correct.

(6) *Issues*

The Appellant's statement of the issues contained in the brief is correct.

(7) *Grouping of the Claims*

All of the claims stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Pat. # 4,894,774, McCarthy et al (Jan. 16, 1990).

Pat. # 4,918,603, Hughes et al (Apr. 17, 1990).

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

- A. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

B. Claims 1, 4-5, 8-9, 12-13, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 2, 13, 2, 10, 2, 10, and 2 respectively of prior U.S. Patent No. 6,204,862 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are almost identical with the exception that in claim 5 of 862 patent, one needs to have many symbolic descriptions of sub-events to infringe the patent versus at least one representation of the sub-event for infringing this application. Wherein the difference is an obvious one, since “at least one” representation also includes “a plurality of” the symbolic representations.

Claim Rejections - 35 USC § 103

C. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action::

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

D. Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy et al, hereinafter McCarthy (Pat. # 4,894,774, 1/16/90), in view of Hughes et al, hereinafter Hughes (Pat. # 4,918,603, 4/17/90).

Regarding independent claim 1, McCarthy discloses a method for transmitting a game simulation; the simulation made up of sub-events—moving, colliding of objects, etc-- being governed by a set of rules—governing the motion of objects, collision detection, etc. The rules

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determine a status change—graphically moving, colliding of objects(col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67). McCarthy fails to explicitly disclose *simulation of a live event*. Hughes teaches the simulation of sports, such as a football game, on a computer (col.2, lines 1-67, and col.16,lines 3-9). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, because Hughes teaches above the simulation of an easy to use football game based on actual performances.

Moreover, McCarthy discloses representing one of the sub-events—moving, colliding of objects, etc—with action involving physical skill, and exertion—moving, colliding of objects(col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67).

Moreover, McCarthy discloses the creation, and updating of a database file for storing information concerning the game—moving, colliding of objects, etc— (col.2, lines 58-col.3, line 10).

Furthermore, McCarthy discloses the updating of array databases in response to moving of objects on a computer screen as per a user request or transmission (col.2, lines 58-col.3, line 10).

Regarding claim 2, which depends on claim 1, McCarthy discloses that the moving, and collision of objects is internally represented by a time slot—beginning and end time—and updating the database based upon the time slot (col.2, lines 58-col.3, line 67).

Claim 3 is directed towards a method for implementing the method found in claim 2, and therefore is similarly rejected.

Regarding claim 4, which depends on claim 1, McCarthy discloses that the moving, and collision of objects is represented by x, y coordinates (col.4, lines 6-67).

Furthermore, McCarthy discloses the creation, and updating of a database file for storing x, y coordinates regarding the moving and collision of objects (col.2, lines 58-col.3, line 10, and col. 8, lines 17-67).

Regarding independent claim 5, the limitations *of a method for transmitting information useful in a computer simulation of a live event....updating the database file* are directed towards the step of claim 1 and therefore are similarly rejected.

Furthermore, McCarthy discloses a method for transmitting a game simulation; the simulation made up of sub-events (col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67). McCarthy fails to explicitly disclose *receiving a request for information...from a viewer computer and transmitting information to the viewer computer*. Hughes teaches the request for the display of menus on a computer, including information about a football game, in response to a user's request (col.2, lines 1-67, col.4, line 41-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, because Hughes teaches above the simulation of an easy to use football game based on actual performances.

Claims 6-16 are directed towards a method for implementing the method found in claims 2, 2, 4, 1-2, 2, 4, 1-2, 2 and 4 respectively, and therefore are similarly rejected.

(11) *Response to Argument*

Regarding Appellants offer to submit a terminal disclaimer to obviate a judicial double patenting rejection (page 5, lines 21-23), the Examiner has replaced the statutory double patenting rejection with a judicial double patenting rejection above, in order to expedite the prosecution of this application.

Regarding Appellants' submission that McCarthy does not disclose an action type selected from a set of action types which represent actions involving physical exertion, and skill (page 8, lines 3-5). The Examiner disagrees, because McCarthy teaches the simulation of a conflict on a playfield, where a user has at least the options of moving and colliding object(s) with other object(s) in a quest to simulate the conflicting activity (col.1, lines 63-col.2, lines 2-20, col. 3, lines 1-10, 56-col.4, line 44). It is needful to point out that the activities represented by the objects, represent actions involving physical exertion and skill. The effort, and skill it takes for a character, such as monster, a boxer, or maybe a football player the like found in Hughes (col.2, lines 9-64, col. 16, lines 3-37), to run or to collide with another represented character.

Moreover, the Appellants state that nothing in McCarthy represents any action involving physical exertion, and skill, because the actions in McCarthy are virtual (page 8, lines 10-12). While McCarthy fails to explicitly teach *live event actions involving physical exertion and skill*. Hughes teaches computer games simulating real life football games (col.2, lines 9-64, col. 16, lines 3-37). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, and represent a game of football with characters representing football player playing, running, colliding with each other in a playing field, because Hughes teaches above the simulation of an easy to use football game based on actual performances, so this provides the benefit of making the game more realistic by allowing a user to select players from actual teams who possess certain skills which allows them to possess certain statistical scoring in a particular activity, such as quarter back, linebacker, etc.

Moreover, the Appellants indicate that Hughes does not teach the transmission of information useful in a computer simulation of a live event (page 8, lines 14-16). However, McCarthy teaches the transmission of simulation information from a user input on a computer screen to a database (col. 2, lines 1-21, 56-67). It is Hughes who teaches computer games simulating real life football games (col.2, lines 9-64, col. 16, lines 3-37). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, and represent a live game of football with characters representing football players playing, running, colliding with each other in a playing field, because Hughes teaches above the simulation of an easy to use football game based on

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actual performances, so this provides the advantage of making the game more realistic, and this would also provide users with the benefit of simulating the conflict, and competition which takes place on a live event such as football, baseball, boxing, etc.

In addition, the Appellants indicate that Hughes teaches a “Fantasy Football” league, which is implemented using menu-driven displays (page 8, lines 17-22). Hughes does not teach a “Fantasy Football” simulation. The prior art teaches a “Fantasy Football” game (col. 1, lines 25-42). Actually, Hughes teaches against “Fantasy Football”, because Hughes discloses the simulation of a live football game which is as realistic as possible. Hughes does this by employing actual live football game statistics (col. 2, lines 9-64, col. 16, lines 3-37), so this teaching of Hughes would provide the benefit of allowing users playing the game taught by McCarthy with the best possible roster of players.

In response to Appellants’ argument that there is no suggestion to combine the references and that Hughes is weak in disclosing the simulation of a live event (page 9, lines 3-17), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McCarthy teaches the simulation of a conflict on a playfield (col. 2, lines 1-21). However, McCarthy fails to explicitly indicate that the conflict has to be a live conflict.

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Hughes teaches a game in which a live event—"football game"—is simulated using some of the statistics of the game, such as rosters of actual football players, drafting, trading of actual football players, etc statistics (col.2, lines 9-64, col. 16, lines 3-37). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, and represent a live game of football with characters representing football player playing, running, colliding with each other in a playing field, because Hughes teaches above the simulation of an easy to use football game based on actual performances, so this provides the advantage of making the game more realistic, and this would also provide users with the benefit of simulating the conflict, and competition which takes place on a live event such as football, baseball, boxing, etc.

In response to the Appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 11, lines 16-19), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellants' disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner disagrees with Appellants' representation of the rejections, in that no motivation to combine the McCarthy and Hughes' references, was provided (page 11, lines 20-22). As the Examiner stated in the office action mailed on 11/18/2002 (lines 11-13), there is a

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motivation to combine the references. Besides, the combination of the references would not render McCarthy unsatisfactory, because Hughes teaches above the simulation of an easy to use football game based on actual performances, so this provides the advantage of making the game more realistic, and this would also provide users with the benefit of simulating the conflict, and competition which takes place on a live event such as football, baseball, boxing, etc.

Further, McCarthy teaches against "Fantasy Football", because Hughes discloses the simulation of a live football game which is as realistic as possible. Hughes does this by employing actual live football game statistics (col.2, lines 9-64, col. 16, lines 3-37).

Moreover, the Appellants submit that the Football team of Hughes cannot be suitably modeled by a virtual game in a playfield involving movements, and collisions (page 12, lines 10-15). The Examiner disagrees, because the teaching of Hughes would provide the benefit of allowing users playing the game taught by McCarthy, to have the best possible roster of players. So that Hughes would provide a user the benefit of assembling the best players before the video game starts.

Conclusion

For all of the reasons stated above the Examiner believes that the rejections should be sustained.

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Respectfully submitted,

Cesar B. Paula


January 9, 2003

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STEPHEN S. HONG
PRIMARY EXAMINER